

REMARKS

A final Office Action was mailed on September 25, 2009, finally rejecting claims 1 – 7, 15 – 23, 31 – 39, 49, 50 and 54 – 56. On November 25, Applicants timely filed a Response to final Office Action, including a Declaration under 37 C.F. R. § 1.131 and other associated exhibits demonstrating that Applicants had completed the invention as claimed prior to the earliest filing date of U.S. Patent No. 7,144,322 to Gomez et al. (“Gomez”), which had been asserted as anticipating each of rejected claims 1 – 7, 15 – 23, 31 – 39, 49, 50 and 54 – 56. An Advisory Action was mailed on December 18, 2009, indicating that the Declaration had not been entered because Applicants had failed at the time of final rejection to provide a showing of good and sufficient reasons why the Declaration had not been earlier presented. Applicants now timely file this Preliminary Amendment together with the Declaration, associated exhibits, a Request for Continued Examination (RCE) and Petition for a one-month extension of time.

Reconsideration of the application in view of the following remarks is respectfully requested.

Status of the Claims

Claims 8, 24-30, and 40 were previously canceled.

Claims 9-14, 41-48, and 51-53 were previously withdrawn from further consideration as being drawn to a non-elected invention.

No claims have been amended.

No new matter has been added.

The listing of claims is presented as a courtesy to the Examiner.

Claims 1-7, 9-23, 31-39, 41-49, and 50-56 are pending.

Declaration Under 37 C.F.R. §1.131

Applicants respectfully submit herewith a Declaration under 37 C.F.R. §1.131 naming Shiro Majima and Keiri Yoshioka as joint inventors, and signed by inventor Shiro Majima (attached as Exhibit 4). It is respectfully submitted that the present application was granted Rule 1.47(a) status on July 22, 2004 (July 22, 2004 Petition Decision Attached as Exhibit 3), and therefore inventor Keiri

Yoshioka's signature is not required. The Declaration states that the Applicants had completed the invention as claimed prior to the earliest filing date of U.S. Patent No. 7,144,322 to Gomez et al. ("Gomez"). Further, Exhibit 1 is a translation of an email correspondence with an Invention Proposal describing the subject matter of the claims of the present application. Exhibit 2 is a copy of the original email correspondence in Japanese.

Applicants respectfully request the Examiner to consider the Declaration enclosed herewith.

Rejection Under 35 U.S.C. §102

Claims 1-7, 15-23, 31-39, 49, 50 and 54-56 were rejected under 35 U.S.C. §102(e) as being anticipated by Gomez.

Applicants respectfully disagree that Gomez shows each and every feature of the presently claimed invention. Nevertheless, Applicants respectfully traverse the rejection in this Response by submitting a Declaration under 37 C.F.R. § 1.131 (along with documentary evidence in the form of Exhibits 1 and 2). The Declaration, signed by inventor Shiro Majima, states that prior to the earliest effective date of Gomez, i.e., August 30, 2002, the inventors had conceived, and used due diligence to reduce to practice, the invention as claimed in the present application. Additionally, Exhibit 1 of the Declaration is a translation of a document describing the features of the game machine recited in the claims of the present application. A copy of the original Japanese document is attached as Exhibit 2.

Accordingly, withdrawal of the rejection of claims 1-7, 15-23, 31-39, 49, 50 and 54-56 under 35 U.S.C. §102(e) based on Gomez is respectfully requested.


CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

The Examiner is respectfully requested to contact the undersigned at the telephone number indicated below if the Examiner believes any issues can be resolved through either a Supplemental Response or an Examiner's Amendment. In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Dated: January 25, 2010

Respectfully submitted,

By 

Thomas J. Bean
Registration No.: 44,528
DARBY & DARBY P.C.
P.O. Box 770
Church Street Station
New York, New York 10008-0770
(212) 527-7700
(212) 527-7701 fax
Attorney For Applicants

Exhibits 1 - 4

EXHIBIT 1

To: [REDACTED]

cc: [REDACTED]

Subject: Received/P1656/Invention/Method for determining game points to be awarded in a mechanical or video-reel slot machine/GC Producing Group 2/[REDACTED] / [REDACTED]
[REDACTED] /PA_HQG-31-020

Received.

[IP Dept. IP Support Group Reiko Nakagawa]

Sender: [REDACTED]

To: [REDACTED]

cc: [REDACTED]

Subject: Invention/Method for determining game points to be awarded in a mechanical or video-reel slot machine/GC Producing Group 2/[REDACTED]
/[REDACTED] /PA_HQG-31-020

GC Department



Response> Invention/Method for determining game points to be awarded in a mechanical or video-reel slot machine/GC Producing Group 2/[REDACTED]
/[REDACTED]

Author: [REDACTED]

Created Date: [REDACTED]

Publication: ☐ General ☒ Limited ☐ Non-disclosure

Sender: [REDACTED]

Date: [REDACTED]

To: [REDACTED]

cc: [REDACTED]

Subject: Invention/Method for determining game points to be awarded in a mechanical or video-reel slot machine/GC Department GC Producing Group 2/[REDACTED]

-----FW by: [REDACTED] Date of FW: [REDACTED] -----

To: [REDACTED]
cc: [REDACTED]
Subject: Invention/Method for determining game points to be awarded in a mechanical or video-reel slot machine/GC Producing Group 2/[REDACTED]

-----FW by: [REDACTED] Date: [REDACTED]
Sender: [REDACTED] Date: [REDACTED]
To: [REDACTED]
cc: [REDACTED]
Subject: Invention/Method for determining game points to be awarded in a mechanical or video-reel slot machine/ GC Department GC Producing Group 2/[REDACTED]

CC320 [REDACTED]

Invention Proposal

(Attach if needed.)

Department [REDACTED] GC Department GC Producing Group 2
Person who notified [REDACTED]
Notification Date [REDACTED]
Related Project [REDACTED]

We notify an invention proposal as follows, under first clause of Article 4 of the company rules, and first clause of Article 3 and first clause of Article 5 of invention handling procedure rules.

Notification type ☒ Patent ☐ Utility Patent ☐ Design Patent

Title of invention/article
Method for determining game points to be awarded in a mechanical or video-reel slot machine

Explanation of invention/article (If it is a design patent, indicate measurements.)

In a regular game or games associated thereto (bonus game and others), at specific number of games (for example, 5 times of bonus games) in which specific symbols spin on reels, the determining game points to be awarded or supplementary numbers are made as the numbers of times in which a special symbol passes a reel window or a payline.

Example)

Passing numbers are displayed per each reel and passing numbers of trigger symbols are counted, and the value obtained by adding the passing numbers at all of the reels is made as the value to be used for multiplying the basic bonus values to obtain bonus award numbers.

Display image (sample)



Examples for setting bonus paylines and counters.

Separated documents to be sent ☒ No ☐ Yes (specification, technical information, others)

Inventor

Department Konami Kabushikikaisha GC Department GC Producing Group 2
Name (furigana) [REDACTED]
Address (furigana) [REDACTED]
Employee No. [REDACTED]
Contributed rate: [REDACTED]

Department Konami Kabushikikaisha GC Department GC Producing Group 2
Name (furigana) [REDACTED]
Address (furigana) [REDACTED]
Employee No. [REDACTED]
Contributed rate: [REDACTED]

Scheduled Publication Date (date of location test, show, publication in magazine, and others) :

<Supplement>

- In a case in which a game content (poker machine) which is installed on a game machine is projected for Australia, publication, sales and installation are not conducted.
- Because it is a given fact that sales permissions for game machines should be authorized by each game authorization agency, sales date of game machines would be changed regardless of our company's scheduled sales date.

Country in which application to be filed.

☒ the United States [REDACTED]

----- (Only for IP Department) -----

Receipt/reference Number: PA-HQG-31-020

Control Number: P1656

Application Number:

Approximate Cost:

Application Date: year month date

Number of Claims:

----- (Route for Notification/Application Proposal) -----

Department in Charge/Person who reported



Department in Charge/Manager (Attn)



Main Department/General manager (Attn)



Main Business Development Department/General Manager (Attn)

Intellectual Property Department/General Manager (Attn)

Patent Strategy Group/Manager (cc)

AM Resident Group/Manger (cc)

GM Resident Group/Manger (cc)

CS Resident Group (cc)
CP Resident Group/Manger (cc)
Intellectual Property Support Group/Every individual (cc) : accepting and processing,
database archiving

(Attn) [REDACTED]

(cc) [REDACTED]

-----Only for Acknowledger (Approval Date/Name of the person who approved/Comments-----
Department in charge/Manager :

[REDACTED] Acknowledged [GC Producing Group 2 [REDACTED]]

Person in charge at IPGC :

[REDACTED] Confirmed [In charge of GC IP Department [REDACTED]]

Main Department/General manager :

[REDACTED] Approved GC Main Business Department [REDACTED]

------(Contact Rout for Reply)-----
Intellectual Property Department/Person in charge of Application

↓
Department in Charge/Person who reported
Department in Charge/Manager (Attn)
Main Department/General manager (Attn)
Main Business Development Department/General Manager (Attn)
Intellectual Property Department/General Manager (Attn)
Patent Strategy Group/Manager (cc)
AM Resident Group/Manger (cc)
GM Resident Group/Manger (cc)
CS Resident Group (cc)
CP Resident Group/Manger (cc)
Intellectual Property Support Group/Every individual (cc) : database archiving

update history

EXHIBIT 2

宛先:
CC:

件名: 受付/P1656/発明考案/メカニカル又はビデオリールスロットマシンにおける配当値決定方法/GC制作2部/
PA-IHQG-91-029

受付けました。

【知的財産部 知的財産サポートグループ 中川礼子】

送信者:

宛先:

CC:

件名: 発明考案/メカニカル又はビデオリールスロットマシンにおける配当値決定方法/GC制作2部/

GC事業本部



返答 > 発明考案/メカニカル又はビデオリールスロットマシンにおける配当値決定方法/GC制作2部/

作成者:

作成日:

公開:

☐ 一般 ☒ 限定 ☐ 非公開

送信者:

宛先:

CC:

件名: 発明考案/メカニカル又はビデオリールスロットマシンにおける配当値決定方法/GC事業本部GC制作2部/

転送者: 転送日:

宛先:

CC:

件名: 発明考案/メカニカル又はビデオリールスロットマシンにおける配当値決定方法/GC事業本部GC制作2部/

転送者: 転送日:

送信者:

宛先:

CC:

件名: 発明考案/メカニカル又はビデオリールスロットマシンにおける配当値決定方法/GC事業本部GC制作2部/

CC320

発明考案届

(必要に応じて添付)

届出部署 GC事業本部 GC制作2部

届出者

届出日

関連プロジェクト

就業規則第4条第1項、発明考案取扱規定第3条第1項及び第5条第1項の規定に従い、下記のとおり発明考案の届出を致します。

届出の種類 ☒ 特許 ☐ 実用新案 ☐ 意匠

発明・物品の名称

メカニカル又はビデオリールスロットマシンにおける配当値決定方法

発明・物品の説明 (意匠の場合は全高寸法も記入してください)

通常ゲーム又はそれに付随するゲーム(ボーナスゲーム等)において、リール上で回転するある特定のシンボルが特定ゲーム回数(例えばボーナスゲーム回数)において、リールウィンドウ又はペイラインを通過した回数値を用いて、配当値又はそれを決定する補助数値とする。

(例)
各リールごとに通過カウンターを表示してトリガーシンボルが通過した数をカウントし、全てのリールにおける通過数値を加算した値を倍率として基本ボーナス値に乘じてボーナス配当とするなど。

画面イメージ(サンプル)



ボーナスペイライン及びカウンターの設定例

別送送付資料 ☒ なし ☐ あり(明細書、技術資料、その他)

発明考案者

所 属 コナミ株式会社 GC事業部 GC制作2部
氏名(フリガナ)
住所(フリガナ)
社員番号
寄与した割合

所 属 コナミ株式会社 GC事業部 GC制作2部
氏名(フリガナ)
住所(フリガナ)
社員番号
寄与した割合

公表予定日(ロケテスト、ショー、雑誌掲載等の日付) :

<補足>

・本州向けゲーミング機器に搭載されるゲームコンテンツ(ボーカーマシン)の場合、日本国内における公開、販売、設置は行われません。
・ゲーミング機器の販売時期は、各ゲーミング認証機関からの認可取得が前提であるため、販売時期は当社の予定に開関係無変更されます。

出 願 国 ☒ 米国 ☐ 他国 (知的財産部 処理欄)

案件番号: PA-HQG-31-020

管理番号: P1655

出願番号:

振込費用:

出 願 日: 年 月 日

請求項数:

----- (届出・出願依頼ルート) -----

担当部署/届出者

担当部署/所属長 (宛)

所属本部/本部長 (宛)

業務推進本部/本部長 (宛)

知的財産部/部長 (宛)

特許戦略グループ/マネージャ (宛)

A M 経営グループ/マネージャ (宛)

G M 経営グループ/マネージャ (宛)

C S 経営グループ/マネージャ (宛)

C P 経営グループ/マネージャ (宛)

知的財産サポートグループ/全員 (宛) : 受付処理、データベース保管処理

----- (承認者記入欄(承認日・承認者名・コメント等)) -----

担当部署/所属長 : 了解 [GC制作2部]

知財GC担当 : 承認 [GC担当 知財部]

所属本部/本部長 : 承認 [GC担当 知財部]

----- (回答連絡ルート) -----

知的財産部/出願担当者

担当部署/届出者 (宛)

担当部署/所属長 (宛)

所属本部/本部長 (宛)

業務推進本部/本部長 (宛)

知的財産部/部長 (宛)

特許戦略グループ/全員 (宛)

A M 経営グループ/全員 (宛)

G M 経営グループ/全員 (宛)

C S 経営グループ/全員 (宛)

C P 経営グループ/全員 (宛)

知的財産サポートグループ/全員 (宛) : データベース保管処理

更新履歴:

EXHIBIT 3



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22315-1450
www.uspto.gov

DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK NY 10150-5257

COPY MAILED

JUL 2 2 2004

OFFICE OF PETITIONS

In re Application of
Shiro Majima et al.
Application No. 10/658,086
Filed: September 9, 2003
Attorney Docket No. 09868/000M893-USO

DECISION ACCORDING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the renewed petition filed under 37 CFR 1.47(a) on June 23, 2004, with a request for a three month extension of time to file.

The petition is GRANTED.

The above-identified application was filed on September 9, 2003, with a declaration naming Shiro Majima and Keiri Yoshioka as joint inventors and signed by inventor Shiro Majima only. A petition was filed on September 9, 2003 with the application requesting status under 37 CFR 1.47 claiming that joint inventor Yoshioka could not be located or refused to execute the declaration. The petition was dismissed in a decision mailed January 23, 2004 because the petition was not substantiated with proof that the complete application had been forwarded to non-signing inventor Yoshioka.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). In view thereof, this application is hereby accorded Rule 1.47(a) status.

In response to the decision dismissing the petition filed September 9, 2003, a statement made by the attorney of record indicates that a complete application packet was sent by the assignee to Mr. Yoshioka and that no reply was received. Additionally, a statement provided by Tsuyoshi Sadamatsu, an officer on behalf of KONAMI, the assignee, indicates that at least on two occasions mailings including the complete application were mailed to Mr. Yoshioka, that at least one of the mailings was delivered and not returned and that several telephone calls were made to Mr. Yoshioka, some personally answered by Mr. Yoshioka and others for which there was no answer.

Thus, as provided in Rule 1.47 (c), this Office will forward notice of this application's filing to the non-signing inventors at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This application will be forwarded to Technology Center 3713 for examination in due process.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (703) 305-4497.


Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions